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appears on the "credit card," and the SST/ATM is the card holder. Automated equipment, or human beings, or possibly other agencies, pay the credit card bills.

The SST/ATM is also equipped with a web browser, which allows customers to browse the Internet at the SST/ATM.

If a customer wishes to make a purchase over the Internet using the browser, the customer is allowed to use the credit card of the SST/ATM for the purchase. This allows the customer to remain anonymous with respect to the seller, which can be desirable in some situations. The customer arranges to repay the SST/ATM in any number of different ways.

**RESPONSE TO 102 - REJECTION OF CLAIMS 1 - 3, 5 - 8, AND 19**

**Claim 1**

Claim 1 recites an ATM which allows a customer to make a purchase over a network (such as the Internet), and states that the customer pays the ATM for the purchase using a credit card.

Claim 1(b) states that the seller does not learn the identity of a customer:

b) an electronic payment mechanism for creating an electronic financial instrument which

i) does not allow the seller to learn either the identity of the user or an account number of the user when the user pays either by

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cash, by credit card, by electronic  
card, or by debit card . . .

Primary Point

Davis expressly states that **the customer's card number is sent to the merchant.**

-- In column 25, lines 8 - 12, he states that  
the card number is part of a "card signature."

-- In column 17, lines 27 and 28, he states:  
"The . . . **signature** is a unique value  
identifying a valid . . . card."

-- In column 18, lines 1 - 5, he states that  
"**the signature**" can be sent to the "merchant  
server."

Therefore, Davis expressly states that the customer's card  
number is sent to the merchant (by way of the "signature"). That  
is contrary to the claim.

Additional points follow.

Point 1

The Office Action, in purporting to find claim 1(a) in the  
Davis reference, cites two passages of Davis. One passage is  
column 6, lines 23 - 52.

That passage states that an ordinary credit card type  
transaction is undertaken, wherein payment is made to a merchant

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by a third party (the credit card company). That passage states, in part:

A payment server on the Internet includes a computer and terminals that contain security cards to handle the transaction, data store, and collection.

Also connected to the client terminal and the payment server over the Internet is a merchant server advertising the goods and/or services offered by a merchant for sale.

In one embodiment of the invention, the merchant server includes a web site and the merchant has contracted with an acquirer (sic) to accept stored-value card payments for goods and/or services purchased over the Internet.

Thus, a consumer may use his . . . stored value card at a client terminal . . . in order to purchase goods and/or services from a remote merchant server.

(Column 6, lines 39 - 51.)

Plainly, this passage describes ordinary purchases made over the Internet. The seller learns (1) the identity, and (2) the credit card number, of the purchaser.

That is in direct contradiction to the claim.

#### Point 2

In again purporting to find claim 1(a), the Office Action also relies on Davis, column 7, lines 6 - 25. That passage states, in part:

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[The customer swipes his credit card through a card reader.]

The transaction amount is captured by the security card or the merchant server for subsequent batch settlement through a clearing and administration system . . .

Again, this passage clearly shows that the seller learns both the credit card number, and identity, of the purchaser.

### Point 3

Applicant requests that the PTO explain how, in Davis, the following events can occur, if the merchant knows neither (1) the identity of, nor (2) the credit card number of, the purchaser, as claim 1 states.

-- How is the merchandise delivered to the customer by the merchant ?

-- How does the customer prove that payment was made for the merchandise ?

-- If the customer has a warranty claim, because the product is defective, what prevents the merchant from asserting that the customer did not pay for the product ? That is, if payment was not made, the customer is in breach of contract, and (ordinarily) has no rights under the warranty (because warranty

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service is part of the seller's obligation, which obligation(s) do not exist if the buyer does not perform his part of the contract).

-- If the product is not delivered to the customer, how does the customer then either (1) get a refund or (2) get a replacement product delivered ?

#### Point 4

Davis, column 1, line 34 et seq., states that, in an Internet transaction, the purchaser transmits his credit card number to the seller. (Lines 37, 38.) Davis states that this creates a problem, because the card number is not transmitted securely. (Lines 39 - 41.)

The undersigned attorney can find no discussion in Davis where he states that this transmission of the card number is omitted. That is, in Davis, the merchant still receives the credit card number, contrary to the claim.

#### Point 5

In attempting to show claim 1(b), which was quoted in part above, the Office Action relies on Davis, column 7, lines 36 - 48. The only relevant part of that passage refers to an "anonymous payment solution." (Column 7, line 43.)

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However, Davis is referring to customers who lack "store accounts" with the merchants from which they purchase items over the Internet. For example, a customer who lacks a Macy's credit card, in Davis's view, is "anonymous" with respect to Macy, when that customer uses a MasterCard to make a purchase from Macy's. (See column 7, lines 6 - 43.)

Further, Davis specifically states that information about the customer, including account information of the purchaser and the identity of the purchaser, is made available to the seller, contrary to Applicant's claims. (Column 13, lines 61 - 64; column 14, lines 44 - 52 and lines 60 - 63; column 15, line 63 - column 16, line 12; column 16, lines 23 - 37; and column 17, lines 34 - 44.)

#### Point 6

The Office Action's interpretation of Davis is directly contrary to the **claims** of Davis. The claims are part of Davis' teachings.

Davis claim 1, last three lines, states that the merchant releases merchandise to the user (ie, to the purchaser). How does the merchant do that, if the merchant does not know the identity of the purchaser ?

#### Point 7

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The Office Action is asserting that Davis' statement of an "anonymous payment solution" shows claim 1(b), which is repeated here:

b) an electronic payment mechanism for creating an electronic financial instrument which

i) does not allow the seller to learn either the identity of the user or an account number of the user when the user pays either by cash, by credit card, by electronic card, or by debit card . . .

Since, on the face of the matter, the three words in Davis "anonymous payment solution" do not seem to show claim 1(b), it is clear that the Office Action is relying on the Doctrine of Inherency. MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

No "basis in fact and/or technical reasoning" has been provided as required by this MPEP section.

Such a "basis" and "reasoning" would seem to be required for an additional reason. The customer in Davis is not truly

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anonymous. Davis refers to a "personal identification number" (also called a PIN) of his smart card. (Column 4, line 4.)

Since a PIN is used in the transactions, the customer is not truly anonymous.

Thus, it is incumbent upon the PTO to explain what "anonymous" means in Davis, since the term cannot be taken literally.

#### Point 8

For a reference to be anticipatory under section 102, the reference must be enabling. (See Patents by D. Chisum, sections 3.06(1)(a) and 304(1).)

Under the PTO's rules, a **negative claim recitation** must find express support in the Specification. MPEP § 2173.05(i) states:

#### Negative Limitations

. . . .

Any negative limitation or exclusionary proviso must have basis in the original disclosure.

. . . .

The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.

Note that a lack of literal basis in the specification for a negative limitation may



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not be sufficient to establish a prima facie case for lack of descriptive support.

Thus, Davis is not enabling for the recitation in question. He cannot anticipate.

Conclusion as to Claim 1

Applicant submits that Davis cannot anticipate claim 1, for at least the reasons discussed above.

This discussion applies to the other claims in this group.

As to claim 19, Applicant points out that, in Davis, the customer makes the payment. The merchant receives the customer's card number, and the payment is transmitted through channels dictated by the customer's card.

The payment in Davis is not "independent" as in claim 19.

**RESPONSE TO 103 - REJECTION OF CLAIMS 4 AND 7**

**Claim 4**

The content of claim 4 has not been shown in the references. The Office Action only asserts that the content is "obvious."

"Obviousness" is not a substitute for showing the claim elements in the references. MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

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Restated, claim elements are not "obvious." Only inventions can be "obvious."

#### **Claim 7**

Even if the reasoning of the Office Action be accepted, claim 7 is still not shown.

The physical proof of a transaction, to which the Office Action alludes, is the common paper receipt. However, that receipt is evidence that payment has been received.

Claim 7 does not recite that. Claim 7 recites evidence that "the electronic financial instrument has been created and sent." That is different from proof-of-payment, which an ordinary receipt indicates.

The word "receipt" is derived from "receive." It is an acknowledgement that payment was "received." The claim does not recite such a receipt.

Stated another way, printers in the prior art serve to print thousands of different things. Appellant is unaware of a printer which prints the item recited in claim 7.

Consequently, the undersigned attorney respectfully traverses the Official Notice, and requests a citation of evidence showing the practice recited in claim 7. (See MPEP § 2144.03.)

**RESPONSE TO 103 - REJECTION OF CLAIM 21**

**Point 1**

Claim 21 states, speaking generally, that the ATM has a credit card. In the specific terms of the claim: "c) using an account assigned to the ATM, transmitting payment to the selected merchant."

That has not been shown in the references.

Asserting that this recitation is "obvious," as the Office Action does, is insufficient. "Obviousness" is not a device for supplying missing claim elements.

From another perspective, only inventions can be obvious, not claim elements.

Consistent with this assertion, there is no legal test available to determine whether, in fact, a given claim element is "obvious." The reason for this absence is that, again, claim elements are not "obvious," only inventions can be obvious.

**Point 2**

No valid teaching has been given for combining the references.

The rationale is that the browser of Drummond is a recognized equivalent of the screen software in Korman.

However, that rationale is self-defeating. If the two items are, in fact, equivalent, then there is no need to perform the substitution. The claim recitations would be found in Korman,

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without the substitution.

Plainly, the substitution is made in order to obtain **new properties**, which are intended to show the claim. That fact indicates that the two items are not equivalent.

### Point 3

MPEP § 2144.06 states:

In order to rely on equivalence as a rationale supporting an obviousness rejection, **the equivalency must be recognized in the prior art**, and cannot be based on . . . the mere fact that the components at issue are functional or mechanical equivalents.

The Office Action has not shown that the equivalency is recognized in the prior art.

### Point 4

It appears that the two items are not equivalent. Drummond is cited as showing a web browser. Korman shows none, and the Office Action admits that.

A web browser allows a user to surf the Internet, that is, visit web sites and download web pages.

Korman's software does not do that, and is concerned with controlling the operation of an ATM.

In fact, Korman states that he does not need the Internet.

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(Page 5, top.) If he does not need the Internet, then clearly he is not designed to browse the Internet.

The two items are plainly not equivalent.

#### **Point 5**

The substitution renders Korman inoperative.

Drummond's browser cannot operate an ATM. Thus, if Drummond's browser is substituted for Korman's software, which runs Korman's ATM, then Korman is rendered inoperative.

This substitution is contrary to MPEP § 2143.01, section 5, which states:

The proposed modification cannot render the prior art unsatisfactory for its intended purpose.

#### **RESPONSE TO 103 - REJECTION OF CLAIM 22**

##### **Point 1**

Rosen is cited as showing the claimed non-identification of the customer.

However, Rosen contains contrary teachings. He states that the customer

- 1) **may be identified**
- or
- 2) **may NOT BE identified.**

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(Column 19, lines 46 - 49.)

No teaching has been given for selecting the latter over the former.

Restated, if you merely combined Rosen with the other references, you get a system wherein two options exist: identification, and non-identification, of the customer.

That fails to show the claim.

#### **Point 2**

The non-identification of Rosen is contrary to Korman. Korman discusses numerous approaches to identifying the customer. (Page 7, line 9 et seq.)

Korman discusses "bill paying." (Page 9, line 11.) How is a "bill" (such as a telephone bill) "paid" without identifying the customer for the bill ?

Korman discusses numerous types of purchases, in which the identity of the buyer is clearly known to the seller. (Page 9, lines 25 - 31.)

These examples illustrate that Korman is contrary to Rosen, as cited, and to the claim.

#### **Point 3**

No valid teaching has been given for combining the references. The rationale is that "added security" is obtained. However,

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several problems exist in this rationale.

#### Problem 1

The Office Action makes an apples-and-oranges comparison. Rosen is concerned with a problem: if a buyer wants to remain anonymous, how does the seller know that the seller will be paid? (Column 1, line 49 et seq.) So Rosen sets up a system wherein "trusted agents" act.

In essence, Rosen sets up an "electronic escrow system." The "escrow agent" receives the merchandise and payment from buyer and seller, and delivers both to the proper parties.

That is a **completely different** system from those of Korman and Drummond. Thus, there is no basis for comparison.

#### Problem 2

The PTO has not shown any problem with security in either Korman or Drummond. Thus, no reason has been shown why somebody would want to increase the (supposedly deficient) security in those references.

#### Problem 3

No evidence has been given explaining why the combination of references actually does increase security.

Further, it appears that, in fact, the opposite is the case.

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The claimed invention (which the combined references supposedly show) states that (1) the customer is not identified to the seller and (2) the account number of the customer is not identified to the seller.


Thus, the seller "has no idea" (as they say) who the customer is. That would seem to **decrease** security.

#### CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

  
Gregory A. Velte  
Reg. No. 30,434

NCR Corporation  
1700 South Patterson Blvd  
WHQ - 3  
Dayton, OH 45479  
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(937) 445 - 4956